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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,630	04/07/2004	Ira Goldstein	B-5415 621828-7	8828
22879 7590 07/14/2008 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400				
EXAMINER FACTOL, NICHOLAS C				
ART UNIT 2625		PAPER NUMBER		
NOTIFICATION DATE 07/14/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/820,630

**Applicant(s)**

GOLDSTEIN ET AL.

**Examiner**

Nicholas C. Pachol

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04/25/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) 25-30, 34-51, 53-56 and 59-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24, 31-33, 52, 57 and 58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 01/21/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of species 1 in the reply filed on 04/25/08 is acknowledged. The traversal is on the ground(s) that the species are not independent and distinct. This is not found persuasive because the species are deemed by the examiner as being independent and distinct. Each of the species contains separate and different species in which a different search and/or classes would have to be searched in order to properly reject all of the originally presented claims.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 25-30, 32, 34-51, 53-56 and 59-71 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 04/25/08.

***Claim Objections***

3. Claims 31, 33, 52, 57, and 58 are objected to because of the following informalities: The claims are indicated as elected in the response but are labeled as withdrawn on the newly submitted claims on 04/25/08. Appropriate correction is required.

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4. Claim 32 is objected to because of the following informalities: Claim 32 was indicated as withdrawn from both applicant's response and newly submitted claims. The examiner is going to treat claim 32 as elected because it fails into the elected species. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Euchner (US 7,111,230).

Regarding Claim 1, Euchner teaches a method of associating in computer memory (Column 5, lines 4-16)

(i) a digital electronic version of printed human-discernible content of a printed document comprising a sheet having a machine-readable pattern adapted to enable the position of a digital pattern reading device to be determined (Column 3, lines 47-59) and said human-discernible content with

(ii) the identity of a sheet upon which the content is printed (Column 4, lines 39-45), the method comprising:

printing the content onto a sheet using a printer, said sheet comprising a pre-patterned sheet that has been pre-printed with said pattern (Column 5, lines 14-16);

transferring a machine-readable identity code between said printer and said sheet at around the time of printing said content (Column 4, lines 41-45); and

storing a correlation between said identity code and said digital electronic version in computer memory (Column 5, lines 4-16).

Regarding Claim 2, Euchner further teaches wherein said identity code is read from said sheet by said printer (Column 9, lines 19-25).

Regarding Claim 3, Euchner further teaches wherein said identity code is printed on said sheet by said printer (Column 4, lines 42-45).

Regarding Claim 4, Euchner further teaches wherein a plurality of sheets have the same pre-printed pattern and are given individual identities by using said printer to apply different machine-readable identity codes to each of them at around the time of printing each sheet (Column 8, lines 4-10).

Regarding Claim 5, Euchner further teaches wherein said machine-readable identity code comprises at least one code from the group:

- (i) a pattern of dots;
- (ii) a pattern of lines;
- (iii) a pattern of printed objects whose positions and/or shapes code for an identity;
- (iv) a position determining pattern;
- (v) a bar code (Column 2, lines 34-36).

Regarding Claim 6, Euchner further teaches wherein a content printer which prints said content onto said pre-patterned sheet has a pattern reading device, and wherein said content printer acquires data from said pre-printed pattern on the said sheet that is to be printed with content, in order to enable the identity of pattern on said sheet to be established, thereby enabling said association to be made in computer memory (Column 4, lines 42-45); said content printer uses data from a digital electronic version of content to print said content onto said pre-patterned sheet (Column 4, lines 40-41); and wherein said association is made in computer memory between said digital electronic version of said content and said identity of pattern (Column 4, lines 38-45).

Regarding Claim 7, Euchner further teaches wherein said pre-printed pattern is associated in computer memory with specific digital electronic content and wherein upon recognition of said pattern using data acquired by said pattern reading device of said content printer (Column 4, lines 42-45), said specific digital electronic content is

caused to be printed onto said pre-patterned sheet as human-discernible content (Column 4, lines 38-45).

Regarding Claim 8, Euchner further teaches wherein different users have different pattern associated with them and wherein upon recognition of their pattern from data from said content printer's pattern reading device said content printer is caused to print user-specific content onto said sheet (Column 5, lines 47-55).

Regarding Claim 9, Euchner further teaches wherein said human-discernible content comprises document-type content and user-specific content, wherein one from the group:

- (i) document-specific content; and
- (ii) user-specific content

is selected by a user, and the other from said group is obtained from a predetermined correlation between said identity code that has been read by said printer and a digital electronic version said content (Column 4, lines 52-62).

Regarding Claim 10, Euchner teaches a method of associating in computer memory a digital electronic version of printed human discernible content of a printed document with a position in a pen or other digital device readable pattern printed on said document (Column 5, lines 26-40), the method comprising:

introducing into a content printer a page of pre-patterned digital paper that has been pre-printed with a position-determining pattern, said pattern being adapted to enable a digital pen to acquire information from said pattern to enable the position of said pen on said pattern to be determined (Column 5, lines 12-16);

printing said content on said digital paper using said content printer (Column 5, lines 12-16);

using said content printer to perform an act at substantially the time of printing said content onto said pre-patterned paper, in addition to printing content, that is instrumental in associating in computer memory, a digital electronic version of said content with an identity of the particular sheet of digital paper upon which said content is printed (Column 4, lines 42-45).,

said association not being essentially dependent upon a knowledge of the order of pages of digital pages in the printer, prior to a printing operation (Column 7, lines 58-61).

Regarding Claim 11, Euchner further teaches wherein said act comprises transferring an identity code identifying said printed document between said printer and said printed document: either from the printer to the document, or from the document to the printer (Column 4, lines 42-45).

Regarding Claim 12, Euchner teaches a method of associating in computer memory a digital electronic version of printed human discernible content of a printed



document with an identity code adapted to identify said document (Column 5, lines 26-40), the method comprising:

using a plurality of pages of pre-patterned digital paper that have been pre-printed with a position-determining pattern, said pattern being adapted to enable a digital pen to acquire information from said pattern to enable the position of said pen on said pattern to be determined (Column 7, lines 56-61);

printing said content on said digital paper using a content printer (Column 7, lines 56-61);

using said content printer to be instrumental in conveying an identity code to or from the paper (Column 4, lines 46-51);

and associating in computer memory, using said code transferred, at the time of printing said content onto said pre-patterned paper, a digital electronic version of said content with the identity code for the particular sheet of digital paper upon which said content is printed (Column 4, lines 38-45).

Regarding Claim 13, Euchner further teaches wherein an identity code adapted to distinguish a specific sheet of pre-pattern digital paper is printed onto said specific sheet as part of an operation of printing said content onto said specific sheet, said identity code being readable by a digital pen and being capable of being used to distinguish data acquired by a digital pen from said specific sheet from data acquired by said pen from other sheets of pre-patterned paper having the same position-determining pattern on them as does said specific sheet (Column 8, lines 4-10).

Regarding Claim 14, Euchner further teaches wherein an identity code adapted to distinguish a specific sheet of pre-patterned digital pattern is printed on said specific sheet in an operation prior to printing said content onto said specific sheet, and wherein a content printer which prints said content onto said pre-patterned paper has an identity code reading device, said content printer being capable of acquiring data from said identity code, said identity code being capable of being used to distinguish data acquired by a digital pen from said specific sheet from data acquired by said pen from other sheets of pre-patterned paper having the same position-determining pattern on them as does said specific sheet, to enable said association to be made between said digital electronic version of said content and said identity code (Column 8, lines 4-10).

Regarding Claim 15, Euchner further teaches wherein a plurality of different identity codes are printed on a respective plurality of pre-patterned sheets each having the same pre-printed position-determining pattern, said identity codes enabling a digital pen to acquire sheet identity data to enable data acquired from each sheet to be distinguished from data acquired from other sheets (Column 8, lines 4-10).

Regarding Claim 16, Euchner further teaches wherein said identity code is associated in computer memory with specific digital electronic content and wherein upon recognition of said identity code using data acquired by said identity code reading device of said content printer (Column 4, lines 42-45), said specific digital electronic

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content is caused to be printed onto said pre-patterned sheet as human discernible content (Column 4, lines 38-45).

Regarding Claim 17, Euchner further teaches wherein different users have different identity codes associated with them and wherein upon recognition of their identity code from data from said content printer's identity code reading device said content printer is caused to print user-specific content onto said sheet (Column 5, lines 46-55).

Regarding Claim 18, Euchner further teaches wherein said identity code is printed in an area of said pre-patterned paper which is from the group:

- (i) free of pattern;
- (ii) substantially free of pattern (Column 4, lines 12-20).

Regarding Claim 19, Euchner further teaches wherein an area of said sheets from the group:

- (i) all of a surface of each of the sheets;
  - (ii) substantially all of a surface of each of the sheets;
  - (iii) at least half of the surface area of each of the sheets;
  - (iv) at least a tenth of the surface area of each of the sheets;
- are pre-printed with pattern (Column 3, lines 60-65).

Regarding Claim 20, Euchner further teaches wherein said pre-printed pattern is printed using a first printer and wherein said content and said identity code are printed by a second, different, printer (Column 5, lines 14-16).

Regarding Claim 22, Euchner further teaches wherein said pre-printed pattern is printed using a first printer and wherein said content is printed using a second, different, printer (Column 5, lines 14-16).

Regarding Claim 31, Euchner teaches a digital printer having a stack of pre-patterned digital paper in a paper supply, said stack of paper comprising a plurality of sheets of digital paper having a digital position-determining pattern pre-printed on them adapted to enable a digital pen to acquire information from the pattern to enable the position of the pen relative to the pattern to be determined (Column 3, lines 47-65 and Column 4, lines 38-46), and wherein the printer is adapted to be linked to a computer for receiving printing commands from the computer and wherein the sheets of pre-printed paper are stacked in an order that is not known to the computer (Column 5, lines 18-25).

Regarding Claim 32, Euchner teaches wherein the stack of paper is from the group:

- (i) sheets of paper each having the same pattern on them;
- (ii) sheets of paper each having different pattern on them;

(iii) sheets of paper each having the same pattern on them and each having a different pre-printed unique identifier;

(iv) sheets of paper each having different pattern on them and each having a different pre-printed unique identifier (Column 5, lines 41-55).

Regarding Claim 33, Euchner teaches a digital printer having a stack of pre-patterned digital paper in a paper supply, said stack of paper comprising a plurality of sheets of digital paper having a digital position-determining pattern pre-printed on them adapted to enable a digital pen to acquire information from the pattern to enable the position of the pen relative to the pattern to be determined, and wherein the sheets of pre-patterned paper are stacked with undetermined pattern upon them, and wherein the sheets of pre-patterned paper have the same pattern on them (Column 5, lines 12-16).

Regarding Claim 52, Euchner teaches a method of combining pen strokes made with a digital pen upon a digital sheet having pen position-determining pattern printed upon it and human-discernible content printed upon it (Column 2, lines 15-23) comprising:

printing said sheet with said pattern in a pre-patterning operation to create a pre-patterned sheet (Column 5, lines 14-16);

subsequently printing said content onto said pre-patterned sheet using a content printer to create a content-printed digital sheet (Column 4, lines 38-45);

transferring an identity code between said content printer and said sheet to enable the identity of said sheet to be established in a subsequent pen-on-sheet writing operation, the transfer of said identity code occurring in the same time frame as printing said content onto said sheet (Column 4, lines 41-45);

associating in computer memory a link between said identity code and an electronic version of said content that was printed on said sheet (Column 5, lines 4-16);

using a digital pen to make pen strokes on said content-printed sheet (Column 4, lines 30-37);

conveying pen-acquired pen-position data, relating to the position of said pen in said pattern to a processor (Column 5, lines 35-40, wherein the server has a processor to process the information);

using the digital pen to acquire said identity code from said content- printed sheet (Column 8, lines 4-10);

the processor using the pen-acquired identity code, the pen acquired pen-position data, and the link between said identity code and said electronic version of said content to combine said pen strokes with said content (Column 5, lines 35-40, wherein the server has a processor to process the information).

Regarding Claim 57, Euchner further teaches use of a printer to print human discernible content onto a pre- patterned sheet of paper (Column 4, lines 38-45), pre-patterned with a position-determining pattern adapted to enable a digital pen to acquire data relating to the position of the pen in the pattern (Column 4, lines 28-37), and also to

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perform a linking act which is instrumental in linking the identity of the sheet upon which specific content is printed and the address in computer memory at which electronic content, equivalent to said printed content, is stored (Column 5, lines 35-40).

Regarding Claim 58, Euchner further teaches wherein said linking act comprises at least one of:

(i) said printer printing an identity code upon said sheet, said identity code being readable by a digital pen;

(ii) said printer having a pattern data acquirer and acquiring data from said pattern pre-printed upon said sheet of paper;

(iii) said printer having an identity code data acquirer and acquiring data from an identity code upon said sheet, said identity code also being readable by a digital pen (Column 8, lines 4-10).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Euchner (US 7,111,230) in view of Coffy (US 6,915,281).

Regarding Claim 21, Euchner does not teach wherein said second printer is

- (i) not capable of printing said pattern satisfactorily; or
- (ii) configured not to be capable of printing said pattern satisfactorily.

Coffy does teach wherein said second printer is

- (i) not capable of printing said pattern satisfactorily; or
- (ii) configured not to be capable of printing said pattern satisfactorily (Column 5, lines 5-10).

Euchner and Coffy are combinable because they both teach editing a hardcopy of a document though the means of an electronic pen.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Euchner with the teachings of Coffy for the purpose of having the best printer available to print the pattern on the paper, To create the best image of the pattern on the paper (Coffy: Column 6, lines 5-10)

9. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over obviousness by Euchner (US 7,111,230).

Regarding Claim 23, Euchner does not teach wherein said first printer has substantially better print resolution than does said second printer.



Official notice is taken that if the printed pattern can be printed by another printer, or pre-printed, then the printer that is doing the printing of the pattern would have better resolution than the second printer.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a printer to print the pattern out on a printer that has better resolution because the printer that has better resolution would be more preferable to print out the pattern.

Regarding Claim 24, Euchner further teaches wherein pre-printed digital paper is taken from said first printer and put into a plurality of second printers (Column 5, lines 14-25) .

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas C. Pachol whose telephone number is 571-270-3433. The examiner can normally be reached on M-Thr, 8:00 a.m.- 4:00 p.m. (EST), Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on 571-272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

N.P.  
07/03/08

/Twyler L. Haskins/  
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